UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087395,588	02/28/95	YOSHIDA	T 35.C10516

EXAMINER
CHAN, J

ART UNIT	PAPER NUMBER
2608	6

DATE MAILED: 09/28/95

FITZPATRICK CELLA
HARPER & SCINTO
277 PARK AVENUE
NEW YORK NY 10172

26M2/0928

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-5 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-5 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☑ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. Claims 1-4 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending application Serial No. 08/389,656 which has a common assignee and one common inventor with the instant application. In application Serial No. 08/389,656 applicants attention is directed to claims 1-6, 8 and 11. When the communication apparatus of copending application switches to the data communication mode, it inherently performs fax communication protocol. Therefore, it executes a communication protocol.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application 08/389,656.

This provisional rejection under Section 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

2. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 1-6, 8 and 11 of copending application Serial No. 08/389,656. Although the conflicting claims are not identical, they are not patentably distinct from each other because when a telephone number received by the apparatus of the copending application coincides with a stored fax number, it will start fax communication. Therefore, a fax communication protocol will be executed.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 6 and 10-12 of copending application Serial No. 08/397,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because when a telephone number received by the apparatus of the copending application coincides with a stored fax number, it will start fax communication. Therefore, a fax communication protocol will be executed.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 15-16, "the communication protocol" lacks antecedent basis.

In claim 3, it is unclear what are meant by "said registration means stores the communication system" and "the communication system of the partner station stored therein" because how can a device or apparatus be stored in a memory? It is the information of the system which stores in the memory, not the system itself.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Davis.

Davis discloses a communication apparatus comprising:

first detection means (step 110);

second detection means (col. 3, lines 62-67 and col. 2, lines 19-21) for detecting information (ANI):

memory means (Figs 3A and 3B); and

means for reading the information of the communication system for the detected information of the partner station from said memory means in accordance with the information of the partner station detected by said second detection means at the time of the detection of the call signal (col. 4, lines 19-26, col. 9, lines 37-42) and executing the communication protocol in accordance with the read information of the communication system (that is, when the detected ANI matches with the stored source number 305-555-5555 in step 240, the operation sequence corresponding to this source number is to connect the line to the device B (col. 9, lines 5-15). Device B is a person computer employing RS232 protocol (col. 4, lines 54-56). Therefore, when device B is connected to the source computer via the line, it executes the RS232 protocol).

7. Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schneyer et al (Schneyer).

Schneyer discloses a communication apparatus comprising:

first detection means (102, col. 5, lines 27-30);

second detection means (col. 5, lines 33-36);

memory means (internal database) for storing the information (i.e. the option for connecting to fax machine) of a communication system (col. 3, lines 5-15); and

means for reading (col. 18, lines 51-57, that is, when the detected number ANI matches with the stored fax number, the incoming call is connected to the fax machine 320 in according to the option which associated with the fax number and a fax communication protocol is executed, col. 3, lines 5-15).

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9. Claims 4 and 5 are rejected under 35 U.S.C. § 103 as being unpatentable over Davis.

Davis differs from claims 4 and 5 of the present invention in that Davis does not specifically disclose that the system

includes systems having different modems. However, Davis in col. 4, lines 51-64 clearly suggests that different modems (different interfaces A-N, see Fig. 2) can be used in his system for connecting different kinds of devices the system (i.e. a G2 fax machine can connect to one interface and a G3 fax machine can connect to another interface). Therefore, it would have been obvious to an artisan of ordinary skill at the time of the invention to use any well known modem such V.21, V.29, V.8 and V.34, etc. as the interface in the system of Davis for allowing the system to receive calls from different kinds of systems.

10. Claims 1-5 are rejected under 35 U.S.C. § 103 as being unpatentable over Yoshida (U.S. Patent No. 5,307,179, cited by applicant) in view of Schneyer et al (Schneyer).

Yoshida in Fig. 2C clearly discloses that when a received calling telephone number matches with a stored telephone number, a G3 communication protocol is executed. Yoshida differs from the claimed invention in that Yoshida does not specifically disclose that the calling telephone number is sent between call signals. However, Schneyer teaches such (col. 5, lines 33-36). Therefore, it would have been obvious to an artisan of ordinary skill at the time of the invention to apply the teaching of Schneyer to the system of Yoshida in order to allow the system of Yoshida to determine the type of communication (i.e. G2 or G3) prior to the connection of the call.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Japanese 62-100074 is cited to show a communication system which stores a telephone number and the associated transmitting speed (protocol) in a memory.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Chan whose telephone number is (703) 305-4729.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Jason Chan
Patent Examiner
Art Unit 2608